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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,533	06/09/2000	EUGENIE CHARRIERE	004900-172	2035

7590 06/29/2004

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/485,533	Applicant(s) CHARRIERE ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-47, 52-54, 56-63 and 66-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-47, 53, 54, 58-63, and 69-72 is/are allowed.
- 6) ☒ Claim(s) 52, 56, 57, 66-68 and 73-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 52, 56, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 9 of claim 52, the language, "less than at least 200°C", renders the claims indefinite, because it cannot be determined what values are intended to be encompassed by the language. It is suggested that applicants use the language that appears elsewhere within the claims; i.e., "not more than 200°C".

2. Claims 67 and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 67, the structures for the isocyanurate of (VIII) and the biuret of (XIII) are incorrect.

With respect to claim 68, it is unclear how the subject matter further limits claim 67. Claim 67 requires a compound of formula (X) and a compound of formula (VIII) or a compound of formula (XIII) or a mixture of (VIII) and (XIII).

3. Claims 66-68 and 73-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claim 66, the language with respect to R<sub>2</sub> appears to be incorrect, because applicants state that the variable optionally bears 1-3 OH groups, then applicants state that the OH groups are substituted. It is questioned if the substitution is to be optional; currently, it is not optional.

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Secondly, the language pertaining to the biuret compound at the end of claim 66 renders the claims indefinite. It is unclear if the biuret compound may be present only with the uretdione compound; in other words, it is unclear if either compound (II) or (III) is required to be present. Furthermore, it is unclear how a biuret compound relates to the structure (VI). Contrary to the claim language, formula (VI) is not an isocyanate, it is merely an isocyanate containing group or radical. Lastly, it is unclear how the biuret of claim 66 relates to the biuret specified within claim 67; it is unclear why two biurets are specified.

Lastly, the second structure of the claim has not been identified as Formula II.

4. Claims 66-68 and 73-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear that the specification provides support for the biuret compound of claim 66, and it is unclear what structure is possessed by the biuret.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 66-68 and 73-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. ('274).

Patentees disclose the use of uretidinedione containing polyisocyanate addition products

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as reactants for the production of coatings, adhesives, foams, and elastomers, wherein the addition products are reacted with polyols, such as polyacrylates and polyesters. See column 5, lines 53+ and column 9, lines 24+. Patentees further disclose that the addition products may be combined with additional polyisocyanate reactants and that the preferred polyisocyanate reactants include biuret containing polyisocyanates. See column 5, lines 31-35.

7. Since it is unclear that claim 66 requires the presence of compounds corresponding to Formula (II) or Formula (III), the prior art rejection is deemed to be appropriate.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).


Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 66-68 and 73-76 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45-49 of copending Application No. 10/682,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is directed to blends of uretdiones and biurets, and their use in the production of coatings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent

June 25, 2004